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10514 U.S. PTO
10/31/97

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. _____
Anticipated Classification of this application:
Class _____ Subclass _____
Prior application: _____
Examiner: Jones
1205
Art Unit: _____

Commissioner of Patents and Trademarks
Washington, D.C. 20231

FILING UNDER 37 CFR 1.60

- WARNING:** A c-i-p (continuation-in-part) cannot be filed under 37 CFR 1.60.
- WARNING:** Filing under 37 CFR 1.60 is permitted only if filed by the same or less than all the inventors named in the prior application.
- WARNING:** The filing of an application as the United States stage of an International Application requires an oath or declaration. 37 CFR 1.61(a)(4).
- WARNING:** The claims of this new application may be finally rejected in the first Office action where all claims of the new application are drawn to the same invention claimed in the earlier application and would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. MPEP § 706.07(b).

This is a request for filing a

- ☒ Continuation
- ☐ Divisional

application under 37 CFR 1.60, of pending prior application

serial no. 08/167,900 filed on July 29, 1994
(date)

of John M. CARNEY and Robert A. FLOYD

(inventor(s))

for SPIN-TRAPPING PHARMACEUTICAL COMPOSITIONS AND METHODS OF USE THEREOF
(title of invention)

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this 37 CFR 1.60 request and the documents referred to as attached therein are being deposited with the United States Postal Service on this date _____ in an envelope as "Express Mail Post Office to Addressee" service under 37 CFR 1.10, Mailing Label Number _____ addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231

(Type or print name of person mailing paper)

(Signature of person mailing paper)

NOTE: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. (37 CFR 1.10(b)).

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NOTE: 37 CFR 1.60 permits the omission of a declaration only if the prior application was complete as set forth in 37 CFR 1.51(a), namely, the prior application comprised at least (1) a specification, including a claim or claims; (2) a declaration; (3) drawings when necessary; and (4) the prescribed filing fee. Accordingly, as presently worded, 37 CFR 1.60 does not permit this procedure to be used where the prior application is pending but only the processing and retention fee required by 37 CFR 1.21(f) is paid or where the declaration was not filed.

1. Copy of Prior Application as Filed Which is Attached

NOTE: Under 37 CFR 1.60 practice signing and execution of the application by the applicant may be omitted provided the copy is supplied by and accompanied by a statement by the applicant or his or her attorney or agent that the application papers comprise a true copy of the prior application as filed and that no amendments referred to in the declaration filed to complete the prior application introduced new matter therein.

NOTE: This statement need not be verified if made by an attorney registered to practice before the PTO. (37 CFR 1.60(b)).

- ☒ I hereby verify that the attached papers are a true copy of what is shown in my records to be the above identified prior application, including the oath or declaration originally filed (37 CFR 1.60)

The copy of the papers of prior application as filed which are attached are as follows:

- ☒ 36 page(s) of specification
☒ 14 page(s) of claims
☒ 1 page(s) of abstract
☐ _____ sheet(s) of drawing

(Also complete 5 below if drawings are to be transferred)

- ☒ 6 pages of declaration and power of attorney

If the copy of the declaration being filed does not show applicant's signature indicate thereon that it was signed and complete the following:

- ☒ In accordance with the indication required by 37 CFR 60(b) my records reflect that the original signed declaration showing applicant's signature was filed on March 25, 1994

- ☐ the amendment referred to in the declaration filed to complete the prior application and I hereby state, in accordance with the requirements of 37 CFR 1.60(b), that this amendment did not introduce new matter therein.

2. Amendments

WARNING: "The claim of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application." MPEP § 706.07(b).

- ☐ Cancel in this application original claims _____ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
- ☐ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

NOTE: Only amendments reducing the number of claims or adding a reference to the prior application (Rule 1.78(a)) will be entered before calculating the filing fee and granting the filing date. 37 CFR 1.60(b).

NOTE: "When filing under Rule 1.60 retain at least one original claim from the patent application to assure a complete application." Notice of March 3, 1986 (1064 O.G. 37-38).

3. Fee Calculation

CLAIMS AS FILED					
Number filed	Number Extra			Rate	Basic Fee \$790.00
Total Claims	16	-20=	0	X	\$ 22.00
Independent Claims	2	-3=	0	X	\$ 82.00
Multiple dependent claim(s), if any				X	\$ 270.00

☐ Fee for extra claims is not being paid at this time.

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency. 37 CFR 1.16(d).

Filing Fee Calculation \$ 790.00

4. Small Entity Status

- ☐ A verified statement that this filing is by a small entity:
- ☐ is attached
 - ☐ has been filed in the parent application and such status is still proper and desired (37 CFR 1.28(a))

Filing Fee Calculation (50% of above) \$

NOTE: Any excess of the full fee paid will be refunded if a verified statement is filed within 2 months of the date of timely payment of a full fee then the excess fee paid will be refunded on request. 37 CFR 1.28(a).

NOTE: 37 CFR 1.28(a), last sentence states: "Applications filed under §1.60 or §1.62 of this part must include a reference to a verified statement in a parent application if status as a small entity is still proper and desired."

5. Drawings

WARNING: Do not check the following box if prior case is not to be abandoned.

- ☐ Transfer the drawings from the prior application to this application and, subject to Item 16 below, abandon said prior application as of the filing date accorded this application. A duplicate copy of this request is enclosed for filing in the prior application file. (May only be used if signed by (1) applicant, (2) assignee of record or (3) attorney or agent of record authorized by 37 CFR 1.138 and before payment of issue fee.)

NOTE: "A registered attorney or agent acting under the provisions of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.138

- ☐ Transfer the following sheet(s) of drawing from the prior application to this application

NOTE: Transferred sheets must be cancelled in prior application. 37 CFR 1.88.

- ☐ New drawings are enclosed
- ☐ formal
 - ☐ informal

NOTE: The Notice of October 7, 1985 (1059 O.G. 2" 39) states the following: "Submission of Drawings—For your convenience and for more effective handling of any drawing corrections which may be necessary, please DO NOT SUBMIT ORIGINAL DRAWINGS WITH PATENT APPLICATIONS. DO SUBMIT THREE HIGH QUALITY COPIES. If the copies submitted pass the formality review and patent examination, no substitute

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drawings will be necessary. If corrections are necessary, they should be made to the original drawings. Either a good copy of the corrected drawings or the corrected original can then be submitted after the Notice of Allowability is mailed." The Notice of November 25, 1985 (1061 O.G. 12) further clarifies the submission of drawing practice by pointing out that the copies that are submitted to the office must be on strong, white, smooth and non-shiny paper and also points out that drawings for patent applications do not need to be submitted on bristol board.

6. Priority—35 U.S.C. 119

- ☐ Priority of application serial no. _____ filed on _____
in _____ (country)
is claimed under 35 U.S.C. 119.
- ☐ The certified copy has been filed in prior U.S. application serial no. _____ on _____
- ☐ the certified copy will follow

7. Relate Back—35 U.S.C. 120

- ☐ Amend the specification by inserting before the first line the sentence:
This is a
☐ continuation
☐ divisional
of co-pending application serial no. _____ filed on _____

8. Inventorship Statement

NOTE: If the continuation or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application. 37 CFR 1.60(b) [emphasis added]

(complete appropriate items (a) and (b))

- (a) With respect to the prior copending U.S. application from which this application claims benefit under 35 USC 120 the inventor(s) in this application is (are):

(complete applicable item below)

- ☒ the same
- ☐ less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:

(Type name(s) of inventor(s) to be deleted)

- (b) The inventorship for all the claims in this application are

- ☒ the same
- ☐ not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted.

9. Assignment

- ☒ The prior application is assigned of record to
OKLAHOMA MEDICAL RESEARCH FOUNDATION AND UNIVERSITY OF
KENTUCKY RESEARCH FOUNDATION
- ☐ an assignment of the invention to _____
is attached

10. Fee Payment B Mad At This Time

- ☐ Not Enclosed
- ☐ No filing fee is submitted. (This and the surcharge required by 37 CFR 1.16(e) can be paid subsequently).
- ☒ Enclosed
- ☒ basic filing fee \$ 790.00
- ☐ recording assignment (\$40.00 37 CFR 1.21(h)(1)) \$
- ☐ processing and retention fee (\$120.00 37 CFR 1.53(d) and 1.21(l)) \$

NOTE: 37 CFR 1.21(l) establishes a fee for processing and retaining any application which is abandoned for failing to complete the application pursuant to 37 CFR 1.53(d) and this, as well as the changes to 37 CFR 1.53 and 1.78 indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee or the processing and retention fee of \$ 1.21(l) within 1 year from notification under § 53(d) must be paid.

Total fees enclosed \$ 790.00

11. Method of Payment of Fees

- ☒ enclosed is a check in the amount of \$ 790.00
- ☐ charge Account No. in the amount of \$
A duplicate of this request is attached.

NOTE: Fees should be itemized in such a manner that is clear for which purpose the fees are paid. 37 CFR 1.22(b).

12. Authorization To Charge Additional Fees

WARNING: If no fees are being paid on filing do not complete this item.

WARNING: Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges if extra claim charges are authorized.

- ☒ The Commissioner is hereby authorized to charge the following additional fees which may be required by this paper and during the entire pendency of the application to Account No. 10-1213
- ☒ 37 CFR 1.16 (filing fees)
- ☒ 37 CFR 1.16 (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 CFR 1.16(d)) it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

- ☒ 37 CFR 1.17 (application processing fees)

WARNING: While 37 CFR 1.17(a), (b), (c) and (d) deal with extensions of time under § 1.136(a) this authorization should be made only with the knowledge that: "Submission of the appropriate extension fee under 37 CFR 1.136(a) is to no avail unless a request or petition for extension is filed." (Emphasis added). Notice of November 5, 1985 (1060 O.G. 27).

- ☐ 37 CFR 1.18 (issue fee at or before mailing Notice of Allowance, pursuant to 37 CFR 1.311(b)).

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 CFR 1.311(b)).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying or at the time of paying . . . issue fee." From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

(37 CFR 1.60 [4-3]—page 5 of 7)

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☒ The power of attorney in the prior application is to

George M. Cooper, Eric S. Spector, Felix J. D'Ambrosio,
Douglas R. Hanscom, James W. Hellwege, William A. Blake,
Colin D. Barnitz

- a. ☐ The power appears in the original papers in the prior application
- b. ☒ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
- c. ☐ A new power has been executed and is attached.
- d. ☒ Address all future communications to

James W. Hellwege
JONES, TULLAR & COOPER, P.C.
P.O. Box 2266 Eads Station
Arlington, VA 22202

14. Maintenance of Copendency of Prior Application

(This item must be completed and the papers filed in the prior application if the period set in the prior application has run)

- ☐ A petition, fee and response has been filed to extend the term in the pending prior application until _____

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the Continuation Application. Notice of November 5, 1985 (1060 O.G. 27)

- ☐ A copy of the petition for extension of time in the prior application is attached.

15. Conditional Petition for Extension of Time in Prior Application

(complete this item and file conditional petition in the prior application if previous item not applicable)

- ☐ a conditional petition for extension of time is being filed in the pending parent application.

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the paper constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).

- ☐ A copy of the conditional petition for extension of time in the prior application is attached.

16. Abandonment of Prior Application (if applicable)

WARNING: (Do not complete this item if the application being filed is a divisional of the prior application which is not being abandoned)

NOTE: "A registered attorney or agent acting under the provisions of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.130.

- ☐ Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application

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is granted and when this application is granted a filing date so as to make this application copending with said prior application.

I hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

James W. Hellwege

Type or print name of person signing

October 31, 1997

Date JONES, TULLAR & COOPER, P.C.
P.O. Box 2266 Eads Station

Signature

P.O. Address of Signatory

Arlington, VA 22202

Tel. No.: (703) 415-1500

Reg. No. 28,808
(if applicable)

- ☐ Inventor
☐ Assignee of complete interest
☐ Person authorized to sign on behalf of assignee
☒ Attorney or agent of record
☐ Filed under Rule 34(a)

(Complete the following if applicable)

Type name of assignee

Address of assignee

Title of person authorized to sign on behalf of assignee

Assignment recorded in PTO on

Reel Frame

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